

REMARKS

This Communication follows Applicants' April 23, 2004 Amendment Under 37 C.F.R. §1.115 that was filed in response to the November 26, 2003 Office Action. The purpose of this Communication is to bring certain matters to the Examiner's attention, these matters being related to Applicants' present application and to their related copending application, Serial No. 08/440,844, filed on June 7, 1995.¹

In presenting new claims 826-1227 in their April 23, 2004 Amendment, Applicants also canceled former claims 576, 578-596, 598-617, 639-658, 660-677, 679-697, 699-716, 718-736, 738-755, 757-775, 777-794 and 796-825. Among the canceled claims were several dependent claims in which the term "metal-containing component" or "ferritin" was recited. These claims included 587, 607, 628, 648, 668, 687, 707, 726, 743, 762, 782 and 801. For example, former and now canceled claim 586 recited "[t]he oligo- or polydeoxyribonucleotide of claim 576, wherein Sig comprises a component selected from the group consisting of biotin, iminobiotin, an electron dense component, a magnetic component, *a metal-containing component*, a fluorescent component, a chemiluminescent component, a chromogenic component or a combination of any of the foregoing. As another example, former claim 587 recited "[t]he oligo- or

¹ In the January 5, 2004 Office Action issued in Serial No. 08/440,844, the Examiner rejected the pending '844 claims under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 576, 578-596, 598-617, 639-658, 660-677, 679-697, 699-716, 718-736, 738-755, 757-775, 777-794 and 796-825 of copending Application No. 08/479,997. On page 5, the January 5, 2004 Office Action states:

... Although the conflicting claims are not identical, they are not patentably distinct from each other because Sig moieties as part of the claimed oligo- or polynucleotides include metal-chelating moiety types. For example, claim 801 of copending 08/479,997 cites ferritin as the Sig moiety which clear[ly] binds the metal atom ion which is therefor a chelator as present as a limitation of all of the instant claims.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

polydeoxyribonucleotide of claim 586, wherein said electron dense component comprises *ferritin*." Thus, any and all of the former claims in this application that recited the terms "metal-containing component" or "ferritin" were canceled in Applicants' April 23, 2004 Amendment.

It is respectfully requested that the Examiner considers the above information as it relates to the present application, Serial No. 08/479,997, and to Applicants' related copending application, Serial No. 08/440,844, and the issue of obviousness-type double patenting raised in the latter.²

Favorable action on this application is respectfully requested.

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² In any case, Applicants' sincerely desire to continue to maintain a clear line of demarcation between the claims in Serial No. 08/479,997 and Serial No. 08/440,844.

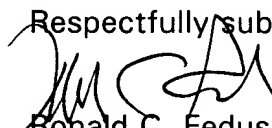
SUMMARY AND CONCLUSIONS

No changes to the specification or the pending claims in this application have been made by this Communication, the purpose of which is to inform the Examiner of certain matters related to Applicants' present application and one of their related copending applications.

No extension request or fee(s) is/are believed due for filing this paper, a Request For Extension Of Time (3 months) and authorization for the fee having been submitted with Applicants' April 23, 2004 Amendment Under 37 C.F.R. §1.115. In the event that any other fee or fees are due, however, authorization is hereby given to charge the amount of any such fee(s) to Deposit Account No. 05-1135, or to credit any overpayment thereto.

If a telephone conversation would further the prosecution of the present application, Applicants' undersigned attorney request that he be contacted at the number provided below.

Respectfully submitted,



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